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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,782	02/13/2002	Peter DeChant	VAL6131P0511US(WP 1646)	7191
32116	7590	01/30/2004	EXAMINER	
WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661			SRIVASTAVA, KAILASH C	
			ART UNIT	PAPER NUMBER
			1651	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,782

Applicant(s)

DECHANT ET AL.

Examiner

Dr. Kailash C. Srivastava

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' amendment filed 11/03/2003 is acknowledged and entered. The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-36 are pending.
3. Newly submitted claim 36 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Said Claim is drawn to a method and is distinct from others because it teaches a method to manage mosquito larvicidal resistance via applying a composition comprising a mixture of *Bacillus sphaericus* and *Bacillus thuringiensis* subspecies *israelensis*. This invention was originally presented and is a non-elected invention (see Office Action dated October 20, 2002).

Since applicants have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 36 as well as claims 1-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Examiner suggests that the non-elected claims be canceled in response to this Office action to expedite prosecution.

Objection to Priority

4. Upon further review and consideration Claims 32-34 are granted benefit of priority under 35 U.S.C. 119(e) according to the filing date of provisional application 60/269,513 filed 02/16/2001.

Claim Rejections - 35 U.S.C. § 112

5. Claims 23-34 and newly presented Claim 35 that is also drawn to a composition comprising a mixture of *Bacillus thuringiensis* subspecies *israelensis* and *Bacillus sphaericus* stand rejected under 35 U.S.C. 112, first and second paragraphs.

In response to this rejection applicants argue that a biological deposit for applicants' isolated *Bacillus thuringiensis* var. *israelensis* and *Bacillus sphaericus* organisms is not required because said microorganisms are wild-type, isolated and biologically pure strains as available to the public under certain trademarks, i.e., VETROBAC, VECTOLEX and SPERIMOS. All are commercial formulations available from Valent Biosciences Corp. However, the relationship between a trademark and the product it identifies is sometimes indefinite, uncertain and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks that are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. Apps. 1931). Furthermore, "To describe physical or other properties of material by mere use of **trademark** is objectionable since it has tendency to make trademark descriptive of product rather than leaving trademark to serve its traditional purpose which is to identify product's source of origin". The issue involved the use of the Trademark **Hypalon** in the claims that Appellants have argued to be within the guidelines of M.P.E.P. 608.01 (v) if the meaning of the trademark is well known and satisfactorily defined in the literature. Copies of articles were submitted. No rejection was made based on first paragraph of 35 USC 112 which was correct

but the rejection was on second paragraph which was considered to be correct by the board. "A patent applicant has an obligation that is imposed by 35 USC 112, second paragraph, to employ claim terminology which is definitive of what the public is not free to use, and use of a trademark in the manner employed by appellant has resulted in claims which fail to meet this obligation in our opinion. see *Ex parte Simpson and Roberts* 218 USPQ 1020.

Applicants arguments are fully considered, however, these are not persuasive for the reasons recited *supra*.

Claim Rejections - 35 U.S.C. § 103

6. Claims 23-35 stand rejected under 35 U.S.C. § 103 (a) as obvious over Rheume et al. (U.S. Patent 5,560,909) in view of Meadows et al (U.S. Patent 5,501,852) for reasons set forth in the Office Action mailed 03/11/2003 and additional reasons discussed below.

In response to the rejections cited *supra* applicants argue that the claimed invention is unobvious over the cited reference, because the cited reference do not disclose or suggest, or provide motivation to arrive at the presently claimed invention because the instantly claimed invention is on the unexpected discovery that the combination of both *Bacillus thuringiensis* subspecies *israelensis* and *Bacillus sphaericus* is effective in controlling dipteran larvae and inhibiting larvicidal resistance to known pesticides. This argument is not deemed to be persuasive because the claims are not commensurate in scope with this unexpected result.

In response to applicants' arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants arguments are fully considered, however, these are not persuasive for the reasons recited *supra*.

CONCLUSION

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


8. No Claims are allowed.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (571) 272-0926 Monday through Thursday.

The fax phone number for the organization where this application or proceeding is assigned is (703)-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

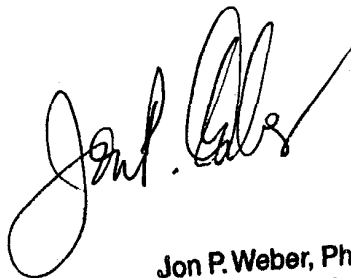

Kailash C. Srivastava, Ph.D.

Patent Examiner

Art Unit 1651

(571) 272-0923

January 28, 2004



Jon P. Weber, Ph.D.
Primary Examiner